

Remarks

Claims 1-8 are presented for reconsideration, with claims 1 and 7 being the independent claims. Claims 1 and 7 are sought to be amended. Applicant reserves the right to prosecute similar or broader claims, with respect to the amended claims, in the future.

These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Examiner Interview

Applicants thank the Examiner for the in-person interview held on January 21, 2009, with Applicants' representative, Michelle K. Holoubek, Reg. No. 54,179. The following topics were discussed during the interview: withdrawal of the previously-filed terminal disclaimer; re-submission of the Declaration of Joel Brooks; and potential amendments to overcome any obviousness-type double patenting rejection that may result from the withdrawal of the terminal disclaimer. The Examiner agreed that re-submitting the Declaration of Joel Brooks along with a Request for Continued Examination would be the appropriate way to have the Declaration considered. No agreement was reached regarding claim amendments.

Rejections under 35 U.S.C. § 102

Claims 1-8 stand rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by the article "FASTBALL.com's 'Decode & Win Game'", by Debra Ray, published in Nov. 1997 (hereinafter, "the FASTBALL article"). Applicants respectfully traverse.

Applicants submit herewith a Declaration by inventor Joel Brooks showing that the FASTBALL article's disclosure was derived from Applicants' own work. As stated in M.P.E.P. § 2132.01, "If the reference is disclosing applicant's own work as derived from him or her, applicant may submit...a 37 CFR 1.132 affidavit to show derivation of the reference subject matter from applicant and invention by applicant. *In re Facius*, 408 F.2d 1396." As stated in the Declaration by Joel Brooks, the promotion referred to in the article is the Applicants' invention. Accordingly, the FASTBALL article does not qualify as a proper reference under 35 U.S.C. § 102(a). Reconsideration and withdrawal of the rejection of claims 1-8 are respectfully requested.

Withdrawal of Terminal Disclaimer

On July 31, 2007, a Terminal Disclaimer was filed to obviate an obviousness-type double patenting rejection over U.S. Pat. No. 6,629,888. It has since been discovered that such a Terminal Disclaimer was filed in error, because the present patent application and the '888 patent were not, and are not, commonly owned. According to M.P.E.P. § 1490(VII)(A), "the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer." Accordingly, a Petition under 37 C.F.R. § 1.182 is filed herewith.

As discussed in the Examiner Interview on January 21, 2009, Applicants recognize that withdrawal of the terminal disclaimer will likely result in an obviousness-type double patenting rejection. In anticipation of such a rejection, Applicants respectfully submit that the invention recited in claims 1-8 of the present application would not be obvious based on the claims of the '888 patent. For example, it would not be obvious to a person having ordinary skill in the art to apply a dull coating to the game piece recited in the '888 patent claims, wherein the dull coating "reduces at least one of the reflectivity of a substrate of the game piece and the contrast between the substrate and the camouflaged image," as recited in amended claims 1 and 7. As indicated in the specification of the present application, "far superior results will be obtained if the coating is used." The present application acknowledges that dull coatings have been used by printers in the past, but also points out that the dull coating of the recited invention has a different purpose, namely "to reduce the reflectivity of the substrate, and to reduce the contrast between the substrate and the printed matter." Accordingly, Applicants submit that claims 1 and 7 and their respective dependent claims should not be subject to any obviousness-type double patenting rejections based on the '888 patent.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all currently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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